

REMARKS

Upon entry of the instant amendment to the claims, claims 3, 5, 8-11 and 13-16 will remain pending in the above identified Application and stand ready for further action on the merits.

The instant amendments to the claims do not incorporate new matter into the application as originally filed. For example, claims 1, 4 and 12 have been cancelled herein, and the remaining dependent claims now ultimately depend from claim 16 (sole independent claim), which is indicated in the outstanding office action at page 6, paragraph “11.” to be allowed.

The current amendment is proper for entry at present as it does not require any further consideration or search on the Examiner’s part and at the same time should result in an immediate allowance of each of pending 3, 5, 8-11 and 13-16. As such, entry of the instant amendment at present, is entirely appropriate under the provisions of 35 USC § 1.116.

Claim rejections under 35 USC §112, First Paragraph

Claims 1, 3-5 and 8-15 have been rejected under the provisions of 35 USC § 112, first paragraph. Reconsideration and withdraw of this rejection is respectfully requested based on the amendments made herein to the claims, wherein claim 1 has been cancelled and remaining dependent claims 3, 5, 8-11 and 13-15 have been amended to all ultimately depend from allowed claim 16.

Claim rejections under 35 USC §§102(b) and 103(a)

At paragraphs “7.” To “10.” of the outstanding office action, the following four (4) separate rejections of pending claims are set forth, over cited art of record.

1. *Claims 1, 3-5, 8, 10, 13 and 15 are rejected under the provisions of 35 USC §102(b) as being anticipated by Plueddemann US '497 (U.S. Patent No. 3,567,497).*
2. *Claims 1, 3-5, 8, 10 and 13-15 are rejected under the provisions of 35 USC §102(b) as being anticipated by GB '405 (GB 735 405).*
3. *Claims 1, 3-5, 8, 10 and 13-15 are rejected under the provisions of 35 USC §102(b) as being anticipated by Mitsutaka GB '632 (GB 2 303 632).*
4. *Claims 1, 3-5, 8-9 and 11-15 are rejected under the provisions of 35 USC §103(a) as being unpatentable over Arakawa US '854 (US 6,103,854) in view of Bigley US '641 (US 5,406,641) as evidenced by Odian (Principles of Polymerization, 2nd Ed., Wiley-Interscience, 1981, p. 226-242).*

Reconsideration and withdrawal of each of the above three anticipation rejections under 35 USC § 102(b), and single obviousness rejection under 35 USC § 103(a), are respectfully requested based on the following considerations.

Legal Standard for Determining Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art.” *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements

must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

“There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed

substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Distinctions Over the Cited Art

As indicated above, the sole independent claim pending in the instant application is claim 16. All remaining claims depend from, or ultimately depend from claim 16, thereby including the limitations of claim 16.

In paragraphs “11.” and “12.” of the outstanding office action, the Examiner states that claim 16 is allowed, and that “[n]one of the above references, taken alone or in combination, teaches or fairly suggest a copolymer having the specific E segment.”

Accordingly, based on such comments, it is submitted that each of instantly pending claims 3, 5, 8-11 and 13-16 are now in condition for allowance, given that all of the claims include the

limitations of claim 16, which as noted by the Examiner is allowed and includes at least one limitation that none of the cited art "teaches or fairly suggests".

CONCLUSION

Each of instantly pending claims 3, 5, 8-11 and 13-16 are now in condition for allowance.

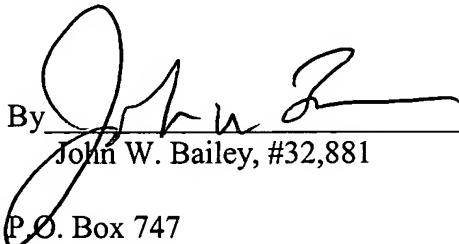
Should the Examiner have any questions concerning the present reply, he is respectfully requested to contact the undersigned at the telephone number provided, in order to expedite further prosecution of the instant case towards allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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